

REMARKS

I. Status of the Claims

Claims 1–18 are pending in the application. All claims were rejected under 35 U.S.C. § 112, 1st ¶, as failing to comply with the written description requirement, and under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,822,081 (“Blöse”). These rejections are respectfully traversed.

The Applicant respectfully notes that the Examiner has not acknowledged the Applicant’s claim for domestic priority under 35 U.S.C. § 120. The Applicant respectfully requests acknowledgement of the claim for priority.

II. Amendments

Claim 10 is amended to be consistent with claim 1. This amendment is not intended to change the scope of claim 10. It merely restates claim 10 in a manner consistent with claim 1. As described below, the specification does convey to a person having ordinary skill in the art that the inventors had possession of the invention recited in amended claim 10 at the time the application was filed. Thus, no new matter is added.

III. Rejections Under § 112

Claims 1–18 were rejected under 35 U.S.C. § 112, 1st ¶, as failing to comply with the written description requirement. Claim 1 recites that “the width of the internal thread and external thread are selected to provide a selected clearance at least between the internal load and stab flanks and the external load and stab flanks upon *final makeup of the connection*.” Claim 10 recites a similar limitation. It is the Examiner’s position that a selected clearance at “final makeup of the connection” is new matter. This rejection is respectfully traversed because the specification does reasonably convey to a person having ordinary skill in the art that the inventors had possession of the invention at the time the application was filed.

The following is a quotation of paragraph 31 from page 7 of the specification. Emphasis is added to the portions on which the Applicant relies to show that the specification conveys the invention to a person having ordinary skill in the art.

The one or more positive stop torque shoulders may move into engagement upon make-up of the connection. The positive stop torque shoulder engagement may occur simultaneously with the stab and load flanks moving into engagement. Alternatively, the stab and load flanks may move into engagement after root and crest engagement during make-up of the connection and followed by the positive stop torque shoulder engagement upon make-up of the connection. In a preferred embodiment, the internal and external thread widths are selected so that a selected clearance exists at least between the internal and external load and stab flanks, upon engagement of the positive stop torque shoulder. ***In this arrangement, torque may be applied to the positive stop torque shoulder prior to final make up, without causing irreversible plastic deformation.***

The specification states that the “positive stop torque shoulders may move into engagement upon make-up of the connection.” A person having ordinary skill in the art would know that “engagement” of a “positive stop torque shoulder” is the equivalent of “final make up.”

Engage means “to interlock or cause to interlock; mesh.” THE AMERICAN HERITAGE COLLEGE DICTIONARY 455 (1996). *Positive* means “marked by or displaying certainty.” *Id.* at 1067. *Engagement* of the positive stop torque shoulder must mean more than mere contact. It means that shoulder is interlocked so that the rotation of the connection in the make-up direction has positively stopped. This is the fully made-up condition. A person having ordinary skill in the art would realize that “engagement” of a positive stop torque shoulder means final makeup of the connection.

Further evidence that a person having ordinary skill in the art would realize that engagement of a positive stop torque shoulder means final makeup of the connection may be found in Blose — the reference cited in the § 102 rejection. Blose states that “both the stab and load flanks gradually converge together during makeup an make contact upon final assembly, whereby axial advancement of the pin member 12 with respect to the box member 13 is

stopped.” Blose states that “[w]hen the joint is fully made up, the converging flanks of the thread provide a positive stop.” Col. 6, ll. 19–31.

In contrast to Blose, the present invention uses a positive stop torque shoulder to stop the axial advancement of the pin member with respect to the box member. Those having ordinary skill in the art would realize that the term “engagement of the positive stop torque shoulder” means final makeup, or “final assembly,” as used in Blose.

Thus, the specification would convey to a person having ordinary skill in the art that the inventors had possession of the invention recited in claims 1 and 10 at the time the application was filed. Dependent claims 2–9 and 11–18 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejections Under § 102

Claims 1–18 were rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 4,822,081 (“Blose”). This rejection is respectfully traversed because Blose does not disclose all of the limitations in the claimed invention.

First, the applicant notes that an Office Action must include an examination of matter added to the claims, even if that matter is the subject of a § 112 rejection, because the new matter rejection may be overcome by the applicant. MPEP §2163.06 (I.). On page 4 of the Office Action, the Examiner stated that “the conditions of the present invention are met given that the added limitations of having a selected clearance at final make up is new matter.” From this, the Applicant assumes that the “final makeup” limitation was not examined. The Applicant respectfully requests examination based on all of the limitations in the claims.

Independent claims 1 and 10 recite a selected clearance between the load and stab flanks upon final make-up of the connection. Blose, on the other hand, discloses the fully made-up condition occurs when the flanks are touching. Blose specifically states that the “stab and load flanks gradually converge together during make-up and make contact upon final assembly.”

Col. 6, ll. 20–21. Thus, Blose does not disclose having a selected clearance between the flanks upon final make-up of the connection.

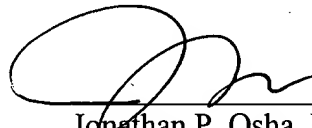
Because Blose does not disclose all of the recited limitations, independent claims 1 and 10 are allowable over the cited art. Dependent claims 2–9 and 11–18 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicant believes this reply to be responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09432/183002).

Respectfully submitted,

Date: 3/6/04



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